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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,267	06/27/2003	Brian Jones	60001.0244US01/MS300530.1	8319

27488 . 7590 12/14/2005

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EXAMINER	
PAULA, CESAR B	

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/608,267	JONES ET AL.	
	Examiner	Art Unit	
	CESAR B. PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 June 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *11-19* is/are allowed.

6)☒ Claim(s) *1,2,6,10 and 20* is/are rejected.

7)☒ Claim(s) *3-5, 7-9, and 21-23* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 June 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the application filed on 6/27/2003.

This action is made Non-Final.

2. Claims 1-23 are pending in the case. Claims 1, 11, and 20 are independent claims.

Drawings

3. The drawings filed on 6/27/2003 have been accepted by the Examiner.

Double Patenting

4. Claim 1 is directed to the same invention as that of claim 27 of commonly assigned application **09/588,411**. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 27 of copending Application No. **09/588,411**. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 1 is provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. **09/588,411** which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or

patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-2, 6, 10, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koppolu et al (Pat. # 5,634,019, 5/27/1997), in view of Harold, E.R., hereinafter Harold, "XML:Extensible Markup Language", IDG Books Worlwide, Books 24x7.com printout, 1998, pages 1-11, and further in view of Park et al, hereinafter Park (Pat. # 6,295,061, 9/25/2001).

Regarding independent claim 1, Koppolu discloses a user indicating to a word processor that a certain embedded object in a document, such as budgeting data (spreadsheet data), is to be

edited. The wordprocessor determines which application is to edit the budgeting data, and negotiates to customize the menu bars by displaying a composite menu bar made up of both wordprocessing menus, and spreadsheet menus (col.7, lines 48-67, col.8, lines 11-42, col.11, lines 23-67, fig.4, 8)-- *determining one or more actions* based on the type of data to be edited; *passing the one or more actions to an application program module for displaying the one or more actions in association with the text string; and displaying the one or more actions in association with the text string.* However, Koppolu fails to explicitly disclose: *receiving a text string annotated with markup language data in an action dynamic link library (DLL); transmitting the text string and the associated markup language data to a plurality of action plug-ins; determining, in the action plug-ins, one or more actions based on the associated markup language data.* However, Harold, teaches using XML tags for describing elements-- *receiving a text string annotated with markup language* (page 1, parag.1-3). Park discloses using a DLL, for utilizing the functions found in plugins (col.5 , lines 59-col.6, line 6). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Koppolu, Harold, and Park, because Park teaches above, the combination of DLL, and plugins can allow a complicated computation to be processed (such as deciding, which menus to display on the menu bar), thus providing the benefit a better service by quickly, and effectively determining which menus to provide to the user.

Regarding claim 2, which depends on claim 1, Koppolu discloses a user indicating to a word processor that a certain embedded object in a document, such as budgeting data (spreadsheet data), is to be edited. The wordprocessor determines which application is to edit the budgeting data, and negotiates to customize the menu bars by displaying a composite menu bar

made up of both wordprocessing menus, and spreadsheet menus (col.7, lines 48-67, col.8, lines 11-42, col.11, lines 23-67, fig.4, 8)-- *obtaining one or more actions associated with the* type of object being edited (spreadsheet object in this case) *for displaying with the plurality of actions.* However, Koppolu fails to explicitly disclose: *for each markup language element of the associated markup language data, parsing a namespace library for equivalent markup language elements; obtaining one or more actions associated with the equivalent markup language elements for displaying with the plurality of actions received from the plurality of action plug-ins.* However, Harold teaches using a dtd for documenting XML tags, which describe document elements. A browser reads and implements the tags from the dtd-- (pages 1 (esp.), 2). Park discloses using a DLL, for utilizing the functions found in plugins (col.5 , lines 59-col.6, line 6)-- *the plurality of actions received from the plurality of action plug-ins.* It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Koppolu, Harold, and Park, because Park teaches above, the combination of DLL, and plugins can allow a complicated computation to be processed (such as deciding, which menus to display on the menu bar), thus providing the benefit a better service by quickly, and effectively determining which menus to provide to the user.

Claim 6 is directed towards computer instructions on a computer-readable medium for storing the steps found in claim 1, and therefore is similarly rejected.

Regarding claim 10, which depends on claim 1, Koppolu discloses a user indicating to a word processor that a certain embedded object in a document, such as budgeting data

(spreadsheet data), is to be edited. The wordprocessor determines which application is to edit the budgeting data, and negotiates to customize the menu bars by displaying a composite menu bar made up of both wordprocessing menus, and spreadsheet menus (col.7, lines 48-67, col.8, lines 11-42, col.11, lines 23-67, fig.4, 8). However, Koppolu fails to explicitly disclose: *the markup language is XML.* However, Harold teaches using a dtd for documenting XML tags, which describe document elements. A browser reads and implements the tags from the dtd-- (pages 1 (esp.), 2). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Koppolu, Harold, and Park, because Harold teaches benefit of extensibility found in the XML language(page 4).

Regarding independent claim 20, Koppolu discloses a user indicating to a word processor that a certain embedded object in a document, such as budgeting data (spreadsheet data), is to be edited. The wordprocessor determines which application is to edit the budgeting data, and negotiates to customize the menu bars by displaying a composite menu bar made up of both wordprocessing menus, and spreadsheet menus (col.7, lines 48-67, col.8, lines 11-42, col.11, lines 23-67, fig.4, 8)-- *an application program module for creating the electronic document; provide additional one or more actions associated with the* type of object being edited (spreadsheet object in this case). However, Koppolu fails to explicitly disclose: *an action dynamically linked library connected to the application program module operative to provide one or more actions associated with one or more markup language elements applied to the string of text a namespace library associated with the application program module for providing one or more equivalent markup language elements that have been designated as equivalent to the one*

or more markup language elements applied to the string of text in the electronic document; and whereby the action dynamically linked library is further operative to provide additional one or more actions associated with the one or more equivalent markup language elements. However, Harold, teaches using XML tags for describing elements. The elements are listed in a dtd-- *one or more markup language elements applied to the string of text a namespace library associated with the application program module for providing one or more equivalent markup language elements that have been designated as equivalent to the one or more markup language elements applied to the string of text in the electronic document* (pages 1 (esp.), 2). Park discloses using a DLL, for utilizing the functions found in plugins (col.5 , lines 59-col.6, line 6). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Koppolu, Harold, and Park, because Park teaches above, the combination of DLL, and plugins can allow a complicated computation to be processed (such as deciding, which menus to display on the menu bar), thus providing the benefit a better service by quickly, and effectively determining which menus to provide to the user.

Allowable Subject Matter

11. Claims 11-19 are allowed.

12. Claims 3-5, 7-9, and 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vertelney et al. (Pat. # 5,341,293 A), Holleran et al. (Pat. # 5,781,189 A), Wolf et al. (Pat. # 5,818,447 A), Schilit et al. (Pat. # 6,658,623 B1), Wolfe (Pat. # 6,336,131 B1), Enns (USPub. # 2002/0065110 A1), Reynar et al. (USPub. # 2002/0178008), Huynh et al. (USPub. # 2002/0198909 A1), Hamzy (Pat. # 6,623,527 B1), Arayasantiparb et al (USPub. # 2003/0220795 A1), Shafron (USPub. # 2004/0165007 A1), Rudd et al. (USPub. # 2005/0120313A1), Noda et al. (Pat. # 6,336,125 B1), **Menu Customizing, IBM TDB, Vol.34, No.1, pages 91-92, 6/1991**, and Erickson et al. (USPub. # 2003/0081791 A1).

II. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The Examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to http://portal.uspto.gov/external/portal/pair. Should you have any questions about

access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:
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- **(571)-273-8300** (for **all** Formal communications intended for entry)

CESAR PAULA
PRIMARY EXAMINER

12/12/05